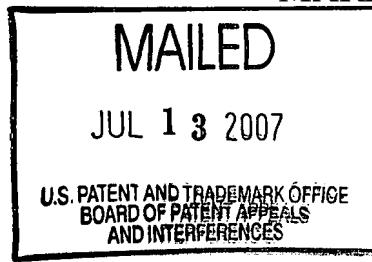


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM B. BROWN,
MARK ALLEN GRUBBS, GERALD FRANCIS MCBREARTY
and
WU ZHENG



Application 10/099,777

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on July 12, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that an ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER was

mailed on March 8, 2006 which requested that a substitute Appeal Brief be filed in compliance with 37 CFR § 41.37. On May 10, 2006, a substitute Appeal Brief was filed. On June 28, 2006, a Notice of Defective Appeal Brief was mailed. In response, another substitute Appeal Brief was filed on July 13, 2006.

APPEAL BRIEF

37 CFR § 41.37(c)(1)(v) (2005) reads as follows:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

....

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The “Summary of claimed subject matter” appearing on pages 3 and 4 of the Appeal Brief filed July 13, 2006 is deficient because it does not map the claimed invention to all of the independent claims. Correction is required.

The Manual of Patent Examining Procedure (MPEP) § 1205.03 (Rev. 3, August 2005) states:

When the Office holds the brief to be defective solely due to appellant’s failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office’s requirement will result in dismissal of the appeal. See MPEP §1215.04 and §711.02(b).

EXAMINER’S ANSWER

While page 1 of the Examiner’s Answer mailed September 26, 2006, states that the Answer “is in response to the appeal brief filed 7/13/2006 appealing from the Office action mailed 3/8/2005,” the comments made under “(10) Response to Argument” all make reference to the Appeal Brief filed 9/20/2005. Correction is required.

Accordingly, it is ORDERED that the application is returned to the Examiner to:

- 1) hold the Appeal Brief filed on July 13, 2006, defective;

- 2) notify appellants to file a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v);
- 3) consider the paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v);
- 4) submit a revised Examiner's Answer which updates the "(10) Response to Argument" section by making reference to the current Appeal Brief; and
- 5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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